



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,317	10/16/2001	Tomoyuki Takeda	35.C15872	4685
5514	7590	07/21/2005	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			HARVEY, DIONNE	
			ART UNIT	PAPER NUMBER
			2646	

DATE MAILED: 07/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/977,317

Applicant(s)

TAKEDA ET AL.

Examiner

Dionne N. Harvey

Art Unit

2643

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) 10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10-20-2003.
- 4) ☒ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: "communication modes"; "state modes".

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 1-9 and 11-13** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 1:

Lines 3- 4 of claim 1 recite "first and second communication modes". By "communication modes" is the Applicant referring to "power saving (ESS)", "park", "Active", "normal" etc. ,If not, clarification is required and the Applicant is requested to point out that portion of the specification where a detailed description of said "communication modes" may be found.

Lines 5-6 of claim 1 recite "first and second state modes". By "state modes" is the Applicant referring to "error state", "printer state", "scanner state", as discussed on page 19, lines 1-5, OR does the Applicant refer to "command through mode" or

Art Unit: 2646

“command return mode” as discussed on pages 23-24? If neither, then clarification is required and the Applicant is requested to point out that portion of the specification where a detailed description of said “state modes” may be found.

Lines 8-9 of claim 1 recite “returning means for responding to an inquiry about a state of said apparatus...”. In reciting “state of said apparatus”, is the Applicant referring back to one of said first and second “state modes”?

Line 11 of claim 1 recites “first process”. Where in the Applicant’s specification can clear discussion of said “first process” be found?

Line 11 of claim 1 recites, “notifying the inquiry from the another apparatus”. Does the Applicant mean to recite “answering the inquiry from the another apparatus...”? Clarification is requested.

Line 12 of claim 1 recites “second process”. Where in the Applicant’s specification can clear discussion of said “second process” be found?

Line 13 of claim 1 recites “generating an inquiry”. Does the Applicant mean to recite “generating a response”?

Line 13 of claim 1 also recites “in place of the another apparatus”. Clarification of this phrase is required.

Line 14 of claim 1 recites, “notifying the generated inquiry”. Does the Applicant mean to recite “sending the generated response”?

Examiner requests that the Applicant point out where a detailed discussion of switching between the first and second process in accordance with the switching between communication modes, can be found in the specification.

The preceding remarks also reply to newly amended claims 12 and 13.

Any other grammatical errors must be corrected so as to provide claims which distinctly claim the Applicant's invention.

Note: Claims 2-9 and 11 are dependent upon claim 1 and thereby encompass the limitations of claim 1. Accordingly, claims 2-9 and 11 are rejected for the same reasons set forth in the U.S.C 112 second paragraph, rejection of claim 1.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8,9,12 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by **Novakov (US 6,571,103)**.

Regarding claims 1,12 and 13, Novakov teaches a method for establishing a communication link between a local station and a mobile unit, reading on “an apparatus having a communication function, comprising:”;

It is well understood in the art that mobile stations, such as cellular telephone devices, are provided with “on” and “off” switches. As such, said on/off switch reads on a “first switching means” for switching between a first “inactive” communication mode, and a second “active” communication mode;

In **column 5, lines 10-12**, Novakov teaches that in the “active” communication mode, and when the mobile station is within the transmission range of a local station having Bluetooth capabilities, a second switching means **32** will switch from a first “GSM radio” state mode, to a second “Bluetooth” state mode, thus meeting the limitation of “in accordance with the switching by said first switching means”

In **figure 1**, Novakov teaches that mobile station **26** is provided with antenna means **42,44**, for responding to inquiries from the local station, said antennas reading on “returning means”.

In **column 5, lines 12-15**, Novakov teaches that in response to an inquiry from the local station, the mobile station will respond that the Bluetooth “state” has been enabled, thus reading on “for responding to an inquiry about the state of said apparatus from another apparatus to which the apparatus is to be connected by the communication function”;

The method of communication disclosed by Novakov includes a plurality of “steps”, each step being interpreted by the Examiner as reading on a plurality of “processes”. So interpreted, the initial step of answering the local station that the mobile station has been Bluetooth enabled, implies an “execution means” for performing the act of determining and sending said answer;

As best understood with respect to the U.S.C. 112 second paragraph rejection above, in **column 6, lines 1-11**, Novakov teaches a further step, which reads on “a second process” wherein, in response to receiving setting commands from the local station, said mobile station generates a confirmation “inquiry” that the setting

Art Unit: 2646

commands have been received and programmed into the Bluetooth transceiver, thus reading on “ a second process of generating an inquiry about the state of said apparatus in place of another apparatus and for notifying the generated inquiry to said returning means”;

Novakov teaches a device which is designed such that it's method of operation moves from one step or “process” to another step or “process” in accordance with the switching from the “inactive” communication mode to the “active” communication mode by way of an on/off switch i.e., “first switching means”, which reads on “process switching means for switching between the first process and the second process in accordance with the switching between communication modes by said first switching means.”

Regarding claim 2, ***as best understood with respect to the U.S.C. 112 second paragraph rejection above***, Novakov appears to teach that the first and second state modes have different power consumptions.

Regarding claim 3, Novakov teaches that the first communication mode is when the first switch is in the “off” position, thereby being in a lower state of power consumption, which reads on “the first and second communication modes have different consumption powers.”

Regarding claim 4, ***as best understood with respect to the U.S.C. 112 second paragraph rejection above***, Novakov teaches that the first switching means (***on/off switch***) is operable to switch the communication mode (***from inactive to active***) when

Art Unit: 2646

the apparatus starts a communication with another apparatus by using the communication function.”

Regarding claim 5, Novakov teaches that the communication function is a wireless function.

Regarding claim 6, Novakov teaches that the communication function is operable to realize communications in conformity with Bluetooth specifications.

Regarding claim 8, ***as best understood with regard to the 35 U.S.C. second paragraph rejection above***, Novakov appears to teach that the second communication mode is a low power consumption mode for reducing power at a communication unit, and said second process is executed during the low power consumption mode at said communication unit.

Regarding claim 9, ***as best understood with regard to the 35 U.S.C. second paragraph rejection above***, Novakov appears to teach that the second communication mode may have a lower power consumption mode and the second state mode is a lower power consumption mode, and wherein the second process generates inquiry when the first switching means switches to a first lower power consumption and said second switching means switches to said first state mode.

Regarding claim 11, ***as best understood with regard to the 35 U.S.C. second paragraph rejection above***, Novakov appears to teach judging means for judging whether switching between second switching means is performed in response to switching by first switching means, wherein said process switching means switches

Art Unit: 2646

between first and second processes in accordance with the judgment from said judging means.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claim 7** is rejected under 35 U.S.C. 103(a) as being unpatentable over **Novakov (US 6,571,103)** in view of **McCleary (US 6,622,031)**.

Regarding claim 7, Novakov does not clearly teach that within the active mode of the Bluetooth specifications are included a park mode, sniff mode and hold mode.

in **column 7, lines 51-59**, McCleary teaches that Bluetooth specifications include a plurality of communication modes including a park mode, a sniff mode and a standby mode.

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the teachings of Novakov and McCleary, thereby permitting the mobile station of Novakov to participate at different levels, in Piconet activity, as is well known and understood in the art.

Response to Arguments

5. Applicant's arguments with respect to claims 1-9 and 11-13 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dionne N Harvey whose telephone number is 703-305-1111. The examiner can normally be reached on 9-6:30 M-F and alternating Friday off.

Art Unit: 2646

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curtis Kuntz can be reached on 703-305-4708. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

D. Harvey


GEORGE ENG
PRIMARY EXAMINER